



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,814	09/13/2000	Donald F. Jemella	P/2167-252	8170
7590 02/18/2005 Edward A Meilman Esq Dickstein Shapiro Morin & Oshinsky LLP 1177 Avenue of the Americas - 41st Floor New York, NY 10036-2714			EXAMINER PATEL, JAGDISH	
			ART UNIT 3624	PAPER NUMBER

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/660,814

Applicant(s)

JEMELLA ET AL.

Examiner

JAGDISH PATEL

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3624

DETAILED ACTION

1. This communication is in response to amendment filed 12/3/04 and subsequent request filed 1/12/05 requesting that the finality of the previous office action be withdrawn. Accordingly this office action is issued as a non-final office action.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/3/04 has been entered.

Response to Amendment/Remarks

3. In response to the applicant's persuasive arguments rejections of claims 1-42 under 1029(e) over Remington et al. (US Pat. 6,070,150) have been withdrawn.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3624

6. Claims 1-42 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. see explanation below.

Claim 1 recites limitation “delivering the request to an automated interface” and then further recites “automatically rendering a decision on the request using the automated interface”. Since, there no attributes are provided which defines the nature of the request a decision on the request cannot be provided. Additionally, at least some processing of the request (the request having attributes such the customer account number, nature of the request etc.) must be performed using the attributes of the request to automatically render the decision. Therefore, it is asserted that the claim in the present form is deficient with respect to specific limitations which define the request received from the customer and processing of the request using the attributes of the request so that the decision is enabled. Note that the receiving step merely adjustment to the account as an intended or desired function but the request itself is not contain any attributes which would facilitate the adjustment to the account.

Claims 11, 12 and 41 also contain similar deficiencies.

Note that all dependent claims also inherit defects of their respective parent claims. Additionally the following deficiencies also renders these claims indefinite:

Claim 7 recites customer information as including name and address of the customer and date of service charge. This input have no connection to the method steps performed by the service charge adjustment system which merely recites receiving the request from the customer, delivering the request.. and automatically rendering the decision.

Art Unit: 3624

Claims 24, 27-28, 33-39 fail to further limit any method steps of parent claim 12. Since all limitations (i.e. process steps) are performed independent of the properties of the "automated interface", it is asserted that none of the method steps are dependent on what other process or functions are performed by it.

Claim 29 recites that the decision on the request is refund. It is unclear how this decision can be reached without the request specifically containing appropriate data concerning the account or service which facilitate refund. Dependent claim 40 also inherit this defect.

Claim 30 is indefinite and unclear for the same reasons as claim 29.

Claims 31-35 recites limitation "the response to the request" which lack sufficient antecedent basis.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1,2,5,6, 8,12, 15, 27,28 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Fleming (US Pat. 5,953,710) (Fleming).

Claim 1: Fleming discloses an apparatus for providing a customer with an opportunity to request an adjustment to said

Art Unit: 3624

customer's account, comprising (refer to Fig. 8 Bank Customer Account Information system 10):

a network interface being operable to send and receive data over an electronic network;
(Fig. 8 telecommunication link)

a service charge adjustment system coupled to the network interface, (Bank Customer Account Information system 10) the service charge adjustment system being operable to perform at least the functions of:

receiving a request from the customer to make an adjustment to the account;

(col. 9 L 65- col. 10 L 12 steps and steps 1 and 2 col. 10,
request is received at the touch-tone telephone and then at the
Bank Customer Account Information system 10)

delivering the request to an automated interface;

(col. 10 and Figure 8 the request is delivered to the Bank Customer Account Information system 10)

automatically rendering a decision on the request using the automated interface;

(as explained in col. 10 steps 1-4b the Bank Customer Account Information system 10 renders a decision on the request

and

presenting the customer with the decision with respect to the request.

(Col. 10 steps 106 and 108).

Claim 2: wherein the automated interface is operable to perform:

Art Unit: 3624

retrieving at least one business rule from a business rules database; (col. 10 55-61,
additional processing which compares the child increase to the security limit) and
applying the at least one business rule to arrive at the decision regarding the request.
(see (col. 10 55-61 refer to step 104 after the security limit value is applied)

Claims 5 and 6: wherein the automated interface is further operable to perform the
functions of:

requesting at least a first customer information; and
validating the first customer information.

(col. 9 L 65+ refer to customer log on process).

Claim 8: wherein the decision is one of the
following:

granting an adjustment request;
denying an adjustment request; ..

(col. 10 L 34-42 4a and b. approval and rejection)

claim 12: all limitations of method claim 12 have been analyzed as per apparatus claim 1
analysis.

Claim 15: the request is made across a computer network (col. 9 L 60-64, ..personal
computer system).

Claim 27: wherein the automated interface establishes a record of the request.

(col. 11 4b L 17-25..record the transaction)

Art Unit: 3624

Claim 28. wherein the automated interface initiates research to determine the validity of the request.

(col. 11 4b L 17-25..if ..available credit is greater than or equal to ..the request is approved)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3-4, 7, 9-11,13,14,16-26 and 29-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleming.

Claims 3-4: Fleming fails to explicitly teach maintaining an electronic site on the network to which the customer may connect.

Official Notice is taken that maintaining an electronic site on the network to which the customer may connect and presenting electronic screen over the network (i.e. web pages) for financial services is old and well known. For example, prior to the instant invention the customer may connect to the web page of a financial institution for account access and basic account related activities.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to maintain an electronic site on the network to access the service charge adjustment system (Bank Customer Account Information system) because this would facilitate access via electronic communication networks such as the Internet providing wider access and continuous availability of the system.

Claim 7 Fleming does not expressly show that the first customer information includes at least the name and address and date of customer of service.

Art Unit: 3624

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The receiving, delivering, rendering a decision and presenting steps would be performed the same regardless of these data. Thus, this (non-functional) descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983), *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to collect from a customer any type of information via the automated interface because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Claim 9: wherein said automated interface is
operable to perform at least one of the following:

validating the existence of a service charge;

checking to see if the customer has a special status;

(col. 10 L 55+ child's card is disabled, ..security limit value associated an account)

Claim 10. (Currently Amended) The apparatus of claim 9, wherein, if the service charge is invalid, including the step of denying said adjustment request.

(col. 10 L 55+ the parent's request is rejected)

Claim 11. Fleming teaches method of providing a customer with an opportunity to electronically request an adjustment to the customer's account as discussed in claim 1 analysis. (Note that the method is as performed by the apparatus recited in claim 1).

Accordingly Fleming discloses the steps of electronically delivering the first input entered by the customer via a touch tone telephone shown in Fig. 8. Fleming teaches step (d) automatically rendering and presenting a decision concerning the request as discussed in claim 1 analysis.

It is noted that while Fleming does not explicitly teach the access of the automated interface, via an electronic site as claimed, there is inherent teaching (col. 9 L 60-64 ..other systems that allow the customer to input and receive information ..personal computer systems, may also be used in this invention).

Official Notice is taken that maintaining an electronic site on the network to which the customer may connect and presenting electronic screen over the network including screens having input fields as claimed and delivering the command to an automated interface (i.e. web pages) for financial services is old and well known. Furthermore, it is old and well known to convert the format of the customer input commands to another format such as encrypting for security and transmission to the financial server. For example, prior to the instant invention the customer may connect to the web page of a financial institution for account access and basic account related activities using these steps.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to maintain an electronic site on the network to access the service charge adjustment system and converting the format of the customer commands as per claim 11 (Bank Customer Account Information system) because this would facilitate access via electronic communication networks such as the Internet providing wider access and continuous availability of the system and would enable the customer to access the automated interface without compromising security of private data.

claim 13: all limitations of method claim 13 have been analyzed as per apparatus claim 3 analysis.

claim 14: all limitations of method claim 13 have been analyzed as per apparatus claims 4 and 5 analysis.

Claim 16: method of providing a customer with an opportunity to request an adjustment to the customer's account according to claim 13 wherein the computer network is the Internet (refer to analysis of claim 4).

Art Unit: 3624

Claims 17-23 Fleming does not explicitly teach alternative methods of receiving and delivering the customer account adjustment request.

Official Notice is taken that receiving and delivering the account related inquiries and requests via different modes of communication are old and well known such modes including telephone, facsimile, mail etc. as per claims 17-23.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to employ any one of the methods of communication of information to facilitate account adjustment request because the customer would be able to use the services using the most convenient method available.

Claim 24-26: refer to discussion of claim 11 for format conversion, noting that the Internet itself is shared operating environment.

Claims 29, 31-40 have been analyzed as containing non functional descriptive material because these limitations do not affect functionality of the underlying method steps. For example, claim 29 refers to the type of decision (i.e. refund). It is noted that the functionality of process steps recited in claims have no relationship to property of the decision. See claim 7 for further details.

Claim 30: decision on the request is denial (see col. 10 "rejection" at step 4a).

Claims 41-42: all limitations of claims 41 and 42 have been analyzed in claims 11 and 2 above.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (703)308-7837.

The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jagdish Patel can be reached on (703)308-7837. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

2/16/05